

Serial No. 10/667,266
Atty. Doc. No. 2002P02639WOUS

REMARKS

Claims 7, 10, 15 and 18 have been amended, and new claims 23 - 26 have been added. Thus, claims 7-26 are presented for examination. Applicants respectfully request allowance of the present application in view of the foregoing amendments.

Response to Objections to the Specification:

The Examiner objected to the abstract for being in the form of two paragraphs. Applicants have amended the abstract to be in the form of a single paragraph.

The Examiner objected to the disclosure for claiming priority as a national stage application. Applicants have amended the disclosure to claim priority as a continuation application.

The Examiner objected to the disclosure for referring to the claims and claim 1. Applicants have amended the disclosure by deleting all references to the claims and claim 1.

Applicants therefore respectfully request withdrawal of the objections to the specification.

Response to Rejections under Section 102:

Claims 15, 17, and 19-22 stand rejected under 35 U.S.C. § 102(b), the Examiner contending that these claims are anticipated by Fernihough (USPAP 2001/0048972).

Applicants have amended the claims to recite that the mask has a layer of ceramic powder comprising zirconium oxide. Fernihough neither discloses nor suggests such a limitation. Fernihough merely teaches a shielding coating 7 (i.e. mask) made of wax or plastic. Spec. para 24. Applicants also respectfully submit that para 26 is directed toward a permanent

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metallic coating 8 applied on top of the removable mask 7. The metallic coating 8 is not ceramic and is not a mask.

Therefore, Applicant respectfully requests that the Examiner withdraw the Section 102 rejection.

Response to Rejections under Section 103:

Claims 7, 9, 10-14 and 18 stand rejected under 35 U.S.C. § 103, the Examiner contending that these claims are anticipated by Fernihough in view of Foster (USPN 4,726,104).

As explained in connection with the Section 102 rejection, Fernihough does not disclose or suggest a mask having a layer of ceramic powder comprising zirconium oxide.

While Foster broadly discloses that the mask properties may be achieved by using "one or more of the single or complex oxides of Group IIA, IIIA, IVA, IIIB, IV elements" or "single or complex oxides of the rare earth elements", it cannot be reasonably contested that all these compositions actually achieve the mask properties (e.g. carbon dioxide (CO₂), iron oxide (Fe₂O₃), propylene oxide (C₃H₆O), nitrous oxide (N₂O), magnesium peroxide (MgO₂)).

Applicants respectfully submit that undue experimentation would be needed for one skilled in the art to select zirconium oxide for Applicants' mask invention from the hundreds, if not thousands compositions included in the group identified in Foster. Importantly, Foster teaches that certain desired mask properties (and, in turn, the mask compositions) are needed for the molten metal welding environment in which the Foster mask is used. See page 3 line 46 – page 4 line 35. This environment, however, is vastly different to Applicants' ceramic spray/vapor deposition environment. As a result, many compositions that meet the Foster mask

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properties may nevertheless be unsuitable or unnecessary for Applicants' mask environment (and vice-versa). For example, Foster explains that its mask must be inert; however, a mask that is inert to molten metal may not be inert to spray/vapor deposited ceramic (and vice-versa). For another example, Foster explains that its mask must have sufficient structural integrity to function as physical barrier to keep molten weld beads from solidifying on the masked surface, however, much less structural integrity is required to mask spray/vapor deposited ceramics.

In view of the amendments to independent claims 7 and 15, Applicants respectfully submit that claims 7 and 15 are patentable. Applicants also respectfully submit that Claims 8-14 and 16-26 are patentable based on their dependency from claims 7 and 15 as well as based on their own merit. For example, claims 23 and 24 recite that the mask comprises an organic binding agent, and claims 25 and 26 recite that the coating is spray or vapor deposited/

Therefore, Applicant respectfully requests that the Examiner withdraw the Section 103 rejection.

Response to Obviousness-Type Double Patenting Provisional Rejection:

The Examiner rejected claims 7, 8, 10-14, 15, 16, and 18-22 under the judicially created doctrine of obviousness-type double patenting, stating that although the subject matter of these claims is not identical to claims 1, 2, 7, 9, 11, 12, 37 and 38 of U.S. Patent Application No. 10/820,483, the pending claims are not patentably distinct from these claims.

While Applicants do not acquiesce to the grounds of the rejection, Applicants submit the accompanying Terminal Disclaimer in accordance with 37 C.F.R. §§ 1.321(b) and 3.73(b) in

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order to promptly resolve this issue. Withdrawal of the double patenting rejection is therefore respectfully requested.

Conclusion

For the foregoing reasons, it is respectfully submitted that the objections and rejections set forth in the outstanding Office Action are inapplicable to the present claims. Accordingly, Applicants respectfully request that the Examiner reconsider the rejections and timely pass the application to allowance.

Please grant any extensions of time required to enter this paper. The commissioner is hereby authorized to charge any appropriate fees due in connection with this paper or credit any overpayments to Deposit Account No. 19-2179.

Respectfully submitted,

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